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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,060	08/21/2003	Olaseni B. Duro-Emanuel	101612-5026-US	6554
28977                      7590                      10/27/2010 MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921				
EXAMINER				
RANKINS, WILLIAM E				
ART UNIT		PAPER NUMBER		
3684				
MAIL DATE		DELIVERY MODE		
10/27/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/645,060

**Applicant(s)**

DURO-EMANUEL ET AL.

**Examiner**

WILLIAM RANKINS

**Art Unit**

3684

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-42, 51-66 and 70-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-42, 51-66, 70-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 35-42 and 51-66 and 70-75 are pending in this application. Claims 73-75 are new.

### ***Response to Arguments***

Applicant's arguments filed 10/06/2010 have been fully considered but they are not persuasive. Regarding the 112 1<sup>st</sup> written description, rejection of claims 35-42 and 51-66 and 70-75 is maintained. The examiner maintains that there is not adequate support for system performing the steps comprising determining whether the money market fund is fully credited.

Regarding the written description rejection, MPEP 2161.01 states;

#### **I. WRITTEN DESCRIPTION**

The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the specification accomplishes this is not material. In re Herschler, 591 F.2d 693, 700-01, 200 USPQ 711, 717 (CCPA 1979) and further reiterated in In re Kaslow, 707 F.2d 1366, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). See also MPEP § 2163 - § 2163.04.

What would have been obvious to one of ordinary skill in the art is not the test. Possession of the invention must be shown by the written description and does not extend to subject matter not disclosed but that would be obvious over what is expressly disclosed. Lockwood V. American Airlines Inc. 41 USPQ 1961.

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Additionally, MPEP 2163.02 states:

Whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement. If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. This conclusion will result in the rejection of the claims affected under 35 U.S.C.112, first paragraph - description requirement, or denial of the benefit of the filing date of a previously filed application, as appropriate.

Applicant submits:

"that if the terms of the money market note are embodied in electronic format, such as a data record, and the credit is represented in electronic format, which notions are fully supported in the specification, then a computer must *necessarily* be involved in determining the extent to which the principal of the money market note is fully credited"

The examiner asserts that a computer may be involved in an electronic funds transfer as described in Para. 0018 of the published specification and in embodying a money market note in an electronic format as described in Para. 0024 of the published specification. However, making an electronic funds transfer or creating an electronic record of a security in no way represent the acts recited in the claims at issue. Additionally, the computers which might perform the acts recited in the specification are not necessarily the computers which would perform the acts recited in the claims. Electronic transfers can be performed by any number of institutions making the ownership of a computer by a person requesting such transfer, initiating the transfer unnecessary, or even utilizing a telephone communication to request the transfer. The communication is clearly done in an electronic manner. Embodying a

security in electronic format also does not require that the owner of the security own a computer.

Finally, the question here is whether a computer is disclosed to perform the steps of the invention. The implied use of computers to perform ancillary actions does not support the use of those same implied computers to perform the steps of the claims. Examiner has reviewed the entire specification and there is no mention of the work "computer" anywhere within the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 35-42, 51-66 and 70-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as disclosed in the office action dated 11/16/2008 and maintained in subsequent actions. For example, independent claim 35 recites:

A system comprising:

Memory operable to store at least one program; and

at least one processor communicatively coupled to the memory, in which the at least one program, when executed by the at least one processor, causes the at least one processor to perform a method comprising:

providing liquidity to a financial transaction in which a term note and a money market note are issued by

upon receiving a payment for principal of the term note, crediting the payment to principal of the money market note if the principal of the money market note is not fully credited, and

crediting the payment to principal of the term note if the principal of the money market note is not fully credited,  
wherein the term note and the money market note have a same credit risk rating.

A review of Para's. 0018, 0019 and 0024 of the applicants' published specification discloses that "the credit... may be represented by a journal entry for an account, which in turn, may be represented in an electronic format." and "Money market note and term note may be embodied...in an electronic form, such as a data record or file associated with an account.

The examiner asserts that nowhere in the specification is there a representation of a system comprising memory and at least one processor as recited in claim 35 and similarly recited in claims 51 and 59. As a result, per the guidance provided in the MPEP, the examiner has determined that possession of the invention, as claimed, has not been shown by the original disclosure.

### ***Conclusion***

This is a continuation of applicant's earlier Application No. 10/645060. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM RANKINS** whose telephone number is (571)270-3465. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/  
Examiner, Art Unit 3684  
10/22/2010

/Kambiz Abdi/  
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